

REMARKS

Claims 1, 58, 60 and 61 have been amended. Claims 31, 32 and 62 have been canceled. Claims 40-44 have been withdrawn from consideration as being directed to non-elected inventions. Thus, claims 1, 6-8, 24, 28, 30, 40-44, 52 and 58-61 are now pending in the present application, with claims 1, 6-8, 24, 28, 30, 52 and 58-61 currently under consideration.

Support for the amendments to Claims 1 and 58 may be found throughout the specification, including, for example, page 17 (lines 3-13, including for example nucleic acid fragments between 15 and 150 nucleotides), Table 1 bridging pages 33-34, and the claims as originally filed. Support for the amendments to claims 60 and 61 may be found throughout the specification including, for example, in claims 31-33 and 53 as filed, Example 2 (pages 33-34), Example 4 (pages 34-35) and Example 8 (page 38). Thus, no new matter has been added.

Reconsideration and withdrawal of the present objection and rejections in view of the comments presented herein are respectfully requested.

Claim objection

Claim 61 was objected to based on the absence of the word “performed” after “is.” Claim 61 as amended now correctly recites “is performed.”

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the claim objection.

Claim interpretation

The Office Action notes that claim 32 “is interpreted as [being] drawn to an isolated nucleic acid comprising a sequence as defined in SEQ ID NO: 1 or a fragment thereof wherein the fragment comprises SEQ ID NO: 3.” Claim 32 has been canceled, thus rendering this issue moot.

Rejection under 35 U.S.C. § 102(e)

Claims 1, 6-8, 32 and 58 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Liu et al. (US 7,407,744). In particular, the Office Action contends that SEQ ID NO: 1 of Liu comprises fragments of SEQ ID NO: 1 of the instant application including SEQ ID NO: 3.

The sequences taught in Liu (and in Pestka cited in the previous Office Action dated June 8, 2010) differ from SEQ ID NO: 1 recited in the present claims in that both the Liu and Pestka sequences have a 76 base pair insertion commencing at residue 245 (of SEQ ID NO: 1).

Claims 1 and 58 recite a sequence defined by SEQ ID NO: 1 or a fragment thereof, which is: (i) less than 150 nucleotides in length; and (ii) comprises SEQ ID NOs: 4 and 9. As illustrated in Exhibit A (last page of this paper), SEQ ID NO: 4 is situated approximately 60 base pairs upstream of the Liu/Pestka sequence insertion point, while SEQ ID NO: 9 lies marginally downstream of this insertion point. Therefore, the recited fragment of SEQ ID NO: 1 spans the Liu/Pestka sequence insertion point, and clearly differs from the Liu/Pestka sequences due to its length which is less than 150 nucleotides. Neither Liu nor Pestka discloses a sequence that is less than 150 nucleotides in length and comprises SEQ ID NO: 4 and SEQ ID NO: 9 as presently claimed.

In view of the reasons set forth above, the Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §102(e).

Rejection under 35 U.S.C. § 103(a)

Claims 24, 28, 30-31, 52 and 59-61 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Liu et al. in view of Williams et al. (US 7,361,460). In particular, the Office Action alleges that it would have been obvious to have used the fragments of Liu et al. which comprise SEQ ID NO: 3 of the present claims to diagnose viral infections by the procedures of Williams et al. with a reasonable expectation of success.

As noted above, the amended claims no longer recite SEQ ID NO: 3, but instead recite a sequence defined by SEQ ID NO: 1 or a fragment thereof, which is: (i) less than 150 nucleotides in length; and (ii) comprises SEQ ID NOs: 4 and 9. Also as noted above, SEQ ID NO: 1 and the fragments thereof recited in the present claim are different than those recited in Liu (and Pestka), which contain a 76 base pair insertion commencing at residue 245 of SEQ ID NO: 1. Neither Liu nor Williams teaches or suggests the presently claimed sequences. Therefore, even in view of this combination of references, it would not have been obvious to include such sequences in a kit as recited in claim 24, or in any of the methods recited in claims 28, 30-31, 52 and 59-61. In addition, the presently claimed sequence encodes a human IL-10 homologue that is expressed during the latent phase of infection and thus can serve as a marker for latent infection. This is neither disclosed nor suggested by any of the cited references.

In view of the reasons set forth above, the Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a).

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

In view of Applicants' amendments to the Claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: April 4, 2011

By: Neil S. Bartfeld/
Neil S. Bartfeld, Ph.D.
Registration No. 39,901
Agent of Record
Customer No. 20995
(858) 707-4000

EXHIBIT A

SEQ ID NO: 1

↵ SEQ ID NO: 3 ↵
cataaaggac cacctacctg ggacgcgcag ttgggcggcg gactgggacg gcatgctgcg 60
gtgatgctgt cggatgatgt ctcttctct ctggctctga tcgtcttttt tctaggcgct 120
tccgaggagg cgaagccggc gacgacgacg acgataaaga a↵ SEQ ID NO: 4 ↵
atacaaagcc gcagtgtcgt 180
ccagaggatt acgcgaccag attgcaagat ctccgcgtca cttttcatcg agtaaaacct 240
acgttg*caac gtgaggacga ctactccgtg ↵ SEQ ID NO: 9 ↵
tggctcgacg gtacgggtggt caaaggctgt 300
↵ SEQ ID NO: 5 ↵
tggggatgca gcgtcatgga ctggttggtg aggcgggtatc tggagatcgt gttccccgca 360
ggcgaccacg tctatcccgg actcaagacg gaattgcata gt↵ SEQ ID NO: 6 ↵
atgctctc gacgctagaa 420
tccatctaca aagacatgcg gcaatgcgta agtgtctctg tggcggcgct gtccgcacag 480
aggtaacaac gtgttcatag cacgctgttt tacttttgtc gggctcccag cctctgttag 540
gttgcgggaga ta↵ SEQ ID NO: 7 ↵
gtccgtg attagtcggc tgtctcagga ggcggaaagg aaatcggata 600
acggcacgcg gaaaggtctc agcgagttgg acacgttggt tag↵ SEQ ID NO: 8 ↵
ccgtctc gaagagtatc 660
tgcaactcgag aagtagcgt tgcgatttgc agtccgctcc ggtgtcgttc acccagttac 720
tttaataaac gtactgttta accrbmdcn 749

* 76 base pair insertion present in "Pestka" and "Liu" sequences